

Application No.: 10/695,657
Amendment dated: August 4, 2005
Reply to Office Action of May 4, 2005
Attorney Docket No.: 21295.69

c.) Remarks

Claims 1-12 are pending in this application. Claims 1-5 and 8-12 have been amended in various particulars as indicated hereinabove.

Turning first to the Office Action Summary Sheet, Claims 1-12 are pending in the application. Claims 1-12 are rejected. The specification and the drawings are objected to by the Examiner.

The drawings were objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1- Reference numeral 14a. The specification has been amended in compliance with 37 CFR 1.121(b).

The specification has been objected to because the Abstract of the Disclosure does not follow certain informalities. Correction to the specification has been made to overcome this informality.

Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ursinus (U.S. Patent No. 2040066) in view of Mori (U.S. Patent No. 3734593) and Zeiss (DE 9413513U1). This rejection is respectfully traversed for the following reasons.

For an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case of obviousness. The Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the cited publications, which must have a suggestion, teaching or motivation for one of ordinary skill in the art to modify a reference or combined references.¹ The cited publications should explicitly provide a reasonable expectation of success, determined from the position of one of ordinary skill in the art at the time the invention was made.²

¹ *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

² *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970);

Amgen v. Chugai Pharmaceuticals Co., 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996);

Application No.: 10/695,657
Amendment dated: August 4, 2005
Reply to Office Action of May 4, 2005
Attorney Docket No.: 21295.69

Independent Claim 1 as amended specifically points out that each of the movable arms has at least one scale. At least one scale disposed on each movable arm allows a user to return the macroscope to an already known setting to repeat an observation of a specimen at the previously established desired conditions. The Ursinus patent does not disclose or even suggest at least one scale on each movable arm, therefore, the device in the Ursinus patent cannot perform the above-described function. The element of at least one scale being associates with each movable arm is not disclosed in the Mori and Zeiss patent either. Therefore, the 103(a) rejection is now improper and should be withdrawn. Allowance of independent Claim 1 is respectfully requested.

Claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ursinus in view of Mori and Zeiss. This rejection is respectfully traversed for the following reasons. Claim 2 depends off now allowable independent Claim 1 and is allowable.

Claims 3-7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ursinus in view of Mori and Zeiss as applied to Claims 1-2 above, and further in view of Scouten *et al.* (U.S. Patent Application Publication US2003/0120282 A1). This rejection is respectfully traversed for the following reasons. Claims 3-7 depend off now allowable independent Claim 1 and are allowable.

Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ursinus in view of Mori and Zeiss as applied to Claim 1 above, and further in view of Bacus *et al.* (U.S. Patent No. 6101265). This rejection is respectfully traversed for the following reasons. Claim 8 depends off now allowable independent Claim 1 and is allowable.

Claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ursinus in view of Mori and Zeiss, and further in view of Bacus *et al.* as applied to Claims 1 and 8 above, and further in view of Scouten *et al.*. This rejection is respectfully traversed for the following reasons. Claim 9 depends off now allowable independent Claim 1 and is allowable.

Application No.: 10/695,657
Amendment dated: August 4, 2005
Reply to Office Action of May 4, 2005
Attorney Docket No.: 21295.69

Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ursinus in view of Mori and Zeiss as applied to Claim 1 above, and further in view of Scouten *et al* and Tasaki *et al.* (U.S. Patent No. 3637283).. This rejection is respectfully traversed for the following reasons. Claim 10 depends off now allowable independent Claim 1 and is allowable.

Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ursinus in view of Mori and Zeiss, and further in view of Tasaki *et al.* and Scouten *et al.* as applied to Claims 1 and 10 above, and further in view of Bacus *et al.*. This rejection is respectfully traversed for the following reasons. Claim 11 depends off now allowable independent Claim 1 and is allowable.

Claim 12 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ursinus in view of Mori and Zeiss as applied to Claim 1 above, and further in view of Bacus *et al.* This rejection is respectfully traversed for the following reasons. Claim 12 depends off now allowable independent Claim 1 and is allowable.

Applicants believe that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

HOUSTON ELISEEVA LLP

By Maria M. Eliseeva
Maria M. Eliseeva
Registration No.: 43,328
Tel.: 781 863 9991
Fax: 781 863 9931

4 Militia Drive, Suite 4
Lexington, Massachusetts 02421
Date: August 4, 2005